APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
LAUFER, F

ART UNIT	PAPER NUMBER
2766	10

DATE MAILED:

01/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on *29 Dec 1999*

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ____3____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

  ☒ Claim(s) *1-73* _____ is/are pending in the application.

    Of the above, claim(s) _____ is/are withdrawn from consideration.

  ☐ Claim(s) _____ is/are allowed.

  ☒ Claim(s) *1-73* _____ is/are rejected.

  ☐ Claim(s) _____ is/are objected to.

  ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

  ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

  ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

  ☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

  ☐ The specification is objected to by the Examiner.

  ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

  ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

      ☐ received.

      ☐ received in Application No. (Series Code/Serial Number) _____ .

      ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

    *Certified copies not received: _____ .

  ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

  ☒ Notice of References Cited, PTO-892

  ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

  ☐ Interview Summary, PTO-413

  ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

  ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Objections Related to Reissue Formalities

2.   The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 U.S.C. § 251

3.   Claims 40-53 and 60-68 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp.* v. *United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

> The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In response to the art rejection in the parent case, (paper #10, dated 21 December 1995) Applicant added the following language to claims 6 and 14 respectively:

Claim 6: (column 18, lines 61-64 of the '646 patent)
"generating a new address header and appending said new address header to said first data packet, thereby generating a modified first data packet"

Claim 14: (column 20, lines 21-22 of the '646 patent)
"generating a new address header for said first data packet"

Furthermore, claims 16 and 17 newly presented as part of the aforementioned response each contained this feature, and Applicant's arguments (page 5) rely on the new header for overcoming the art rejection.

Applicant argues that claims to decryption need not recite the generation of a new address header.

Response: The decryption is the complementary process to the encryption. Therefore, although the step of "generating" is not appropriate, the decryption process claimed must contain the second header as well to avoid the recapturing the material implicitly.

Claim Rejections - 35 U.S.C. § 112

4.   Claims 1-5, 11-13, 18-25, 44-47, 54-55, 61, and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 11: These claims could still use clarification. That is, in claim 1 step 7, need the following alternatives - If no encapsulation header or encapsulation header indicates no encryption then step 10, else step 8. Similarly claim 11 step 6 - If no encryption (determined either by no encapsulation header or from the header) then done, else move on to decryption steps.

Claim 18: "data packet" is used inconsistently in lines 10 and 12. As noted in ¶10, of the previous office action:

> Note also, the use of data packet in the claims sometimes means the
> entire packet (header + data; Claim 18 line 11) and elsewhere means
> the data section without the header. (claim 18, line 14).

Specifically, only a portion of the data packet is decrypted (body, not header). If my interpretation is incorrect, then please inform me about the correct interpretation, and the rejection of 18, 19, and 21 will be withdrawn. If my interpretation is correct, then inserting "a portion of " or "the body of" after "encrypting" on line 12 should solve the problem.

Claim 20 line 7: "the new data packet" lacks antecedent basis.

Claim 22: It is not clear which address is referred to in the phrase "wherein the address information is encrypted"

Claim 44 is not clear: (a) what does "the data packet" refer to (b) "for the decrypted data packet"?

Claim 54 last line: "said decryption key" lacks antecedent basis

Claims 61 and 65: The claim is unclear. Is this meant to be a second decryption?

The aforementioned ambiguities render the claims and those depending from them indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Claim Rejections - 35 U.S.C. § 102

5.   Claims 32-33, 40-41, 44-53 are rejected under 35 U.S.C. § 102(b) as being anticipated by White (WO 92/02095). This is the priority document of White ('303) which is already of record. The rejection is made on the WO publication because of its earlier date. The ESA is the host address, and the Site Address (for entry into the WAN) is a network address which is the same as the "broadcast address" as defined in applicant's disclosure.

6.   Claims 1-73 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Adams Jr. et al. ('782). Note that this patent issued on a c-i-p of application 28,437 (March 1993), while the Adams, Jr. ('708) patent issued on a continuation of application 28,437 (March 1993). This application includes a second embodiment referred to as the "tunneling mode" depicted in Figures 7B and 9. Adams ('782) teaches a CNEDD (which can be configured as part of a PC, workstation, bridge, router etc. - see claims) which examines the header of a packet and consults a table which includes handling instructions for the packet based on source, destination or other information provided in the header. When the handling determines that encryption is called for: (a) in the standard mode, the header is modified and then recombined with the data packet to achieve a "modified packet". On the receiving end the header is examined to determine whether the data should be decrypted by consulting a table similar to the one at the transmitting side [8:15-9:15 for details]; (b) in "tunneling" mode, the header is also encrypted and an additional header with new routing information is added. [6:63-7:6]. The new header may merely copy the routing information, but [9:57-10:2] it can also replace the source and destination addresses with the CNEDD address and the target network address. The inverse process takes place at the receiving end.

The tunneling mode meets all the claims. In this mode, the modified header is an additional header which is attached after encrypted the entire data packet (data field + header field). With respect to the computer program product and computer system claims, Adams is clearly being performed by software control of a system. Therefore, the computer program product and the code itself are inherent.

Applicant argues that Adams Jr. et al. (a) does not identify an encryption method in the header of the encrypted data packet (Claims 1, 6, 11, 16, 17, 20, 24, 26, 36, 38, 54, 60, 64, and 67); and (b) does not replace source and destination addresses with broadcast addresses (Claims 7, 14, 18, 22, 40, 50, 52, 57, 58, and 59) or network address (Claims 32 and 33) in the new header but replaces them with CNEDD addresses.

Response:
        (a)   The claims are broader than "identify" - they claim "providing a mechanism for identifying" which can be "indirect". Adams ('782) states that (even in the first embodiment where the routing information is unchanged) the new header is modified to indicate whether data has been

encrypted, and the number of padding bytes in the encryption. This is a mechanism for identifying" the encryption method.

(b) Note that the CNEDD (10) address is a network address. See [9:66-10:2] which states: "Accordingly it is preferred that the source of the packet is CNEDD 10, and the destination of the information is a CNEDD in the network which contains the target node." and [10:55:61] which refers to Figure 4b showing the "combined gateway and CNEDD". That is, the gateway (CNEDD) address is used in the new header.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information Regarding Communication with the PTO

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

January 3, 2000

Pinchus M. Laufer
Primary Examiner
Art Unit 2766